

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Venegas, Jr.

Serial No.: 09/597,318

Group No.: 3635

Filed: June 19, 2000

Examiner: W. Yip

For: STANCHION SLEEVE AND METHOD OF USING SAME

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed January 23, 2008, Appellant hereby submits its Reply Brief.

New Grounds of Rejection To Be Reviewed On Appeal

A. The rejection of claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr.

B. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. as applied to claim 8, and further in view of U.S. Patent No. 3,319,328 to Finger et al.

Argument

1. The rejection of claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr.

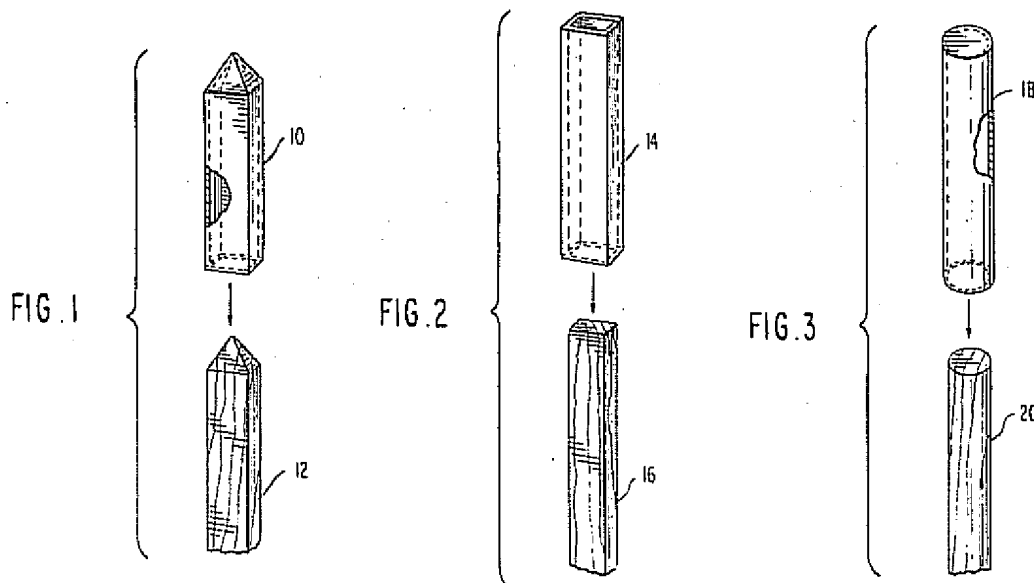
Claim 8 is directed to a cover for a post ... *consisting of:*

“an elongated, generally cylindrical plastic sleeve having an open lower end and a closed, hemispherically shaped upper end; and
the sleeve having a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches.”

The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In're Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

Claim 8 stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. The Examiner acknowledges that Beatty does not disclose a hemispherical top, but argues that it would have been obvious to combine Beatty with Arth, Jr. "for providing a deformable and cushionable protection over the post..." However, *neither Appellant nor the prior art articulates any need for "deformable" or "cushionable" protection.*

In all embodiments of Beatty, the inner surfaces of the coverings match the cuts or surfaces made on a wooden post, as on the next page:



Given that Beatty is intended to utilize a top which is *conformal* to flat cuts made at the top of a post, there is nothing obvious about the conversion of a flat top to a hemispherical top, since there are no hemispherically-topped posts disclosed in the '756 patent. Moreover, even if the Examiner's proposed combination were legitimate, the combination includes other essential components, namely, the strap 12 and interlocking inner flared lip of Arth, Jr. Accordingly, *prima facie* obviousness has not been established.

2. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. as applied to claim 8. and further in view of U.S. Patent No. 3,319,328 to Finger et al.

Claim 12 adds to claim 8 that the sleeve further includes an additive to resist ultraviolet deterioration. The Examiner argues that Arth, Jr. and Beatty teach all [of Appellant's] structural limitations... (Examiner's Answer, page 7) The problem, as discussed above, it that they teach much more than Appellant's "consisting of" claim. Apart from there being no motivation to combine all of the references, the Finger discloses *a coating* as opposed to *an additive*. "The cap may be treated by coating, dipping or spraying with an ozone resistant material and may be given treatment for protection against ultra violet rays." ('328 Patent; 5:15-17). Thus, even if the Examiner's proposed combination were justified, Appellant's invention would not result.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

Date: March 24, 2008

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